

## REMARKS

In the final Office action mailed on October 1, 2004, claims 40-51 were allowed. Claims 52 and 53, however, were rejected under 35 U.S.C. 102(b) as being anticipated by Edwards (U.S. Patent No. 5,505,730). Claims 54-56 have been objected to as being dependent upon rejected claim 52, but are considered to be otherwise allowable.

By the present Amendment, the title for the present application has been amended to delete the words "METHOD FOR." Claims 40-56 remain pending and under consideration in the present application. Applicant respectfully requests reconsideration of the present application.

In the Section 102(b) rejection of claims 52 and 53 based on Edwards, the Office action asserted that "Edwards discloses a catheter (14) having an energy application device (12) that is expandable and sized for insertion into a vein, and a fluid delivery vessel (60)."

Applicant respectfully submits that Edwards describes an ablation apparatus (for body organs including but not limited to the uterus, gall bladder, large intestine and the like) with an introducer sleeve (14), a balloon (12), and a conductive surface (24). Edwards also discloses an electrolytic solution source (60) where electrolytic solution flows to and from the balloon (12). *See* Edwards at col. 6, lines 64-67. Edwards discloses that the balloon has apertures, and "electrolytic solution is permitted to selectively flow [from the balloon] through one of apertures." *See* Edwards at col. 2, lines 44-49. "Electrolytic solution and RF energy are delivered through the conductive surface to the inner layer." *See* Edwards at col. 2, lines 52-53. Thus, Edwards discloses that the electrolytic solution and RF energy are delivered to the same location such as the endometrium.

Applicant respectfully submits that this is different from the claimed invention. Applicant respectfully notes that claim 52 recites a catheter having an energy application device that is placed in "apposition with the inner wall of the vein" and "a fluid delivery

vessel capable of delivering ... fluid into the tissue surrounding the vein" (emphasis added). Thus, the catheter and energy application device are designed for use within a vein (*i.e.*, intraluminally), while the fluid delivery device is capable of delivering fluid into the tissue surrounding the vein. Even assuming that the Edwards apparatus were sized for use in a vein (which it is not), the fluid delivery vessel would deliver fluid intraluminally within the vein, and not into the tissue surrounding the vein as required by the claims. Moreover, there is no suggestion in Edwards to modify its apparatus for such a result. Nor was any such motivation identified in the Office action. For at least this reason, Applicant respectfully requests that the Section 102 rejection of claims 52 and 53 be withdrawn.

#### CONCLUSION

Applicant respectfully requests favorable reconsideration of the claims at an early date. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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